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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/871,978	06/04/2001	Makoto Hatakenaka	401191	5265

23548 7590 10/06/2003
LEYDIG VOIT & MAYER, LTD
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WASHINGTON, DC 20005-3960

EXAMINER

TON, DAVID

ART UNIT	PAPER NUMBER
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2133

DATE MAILED: 10/06/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/871,978

Applicant(s)

HATAKENAKA ET AL. 

Examiner

David Ton

Art Unit

2133

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 January 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 7-9 is/are allowed.
- 6) ☒ Claim(s) 1 and 10-18 is/are rejected.
- 7) ☒ Claim(s) 2-6 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 08/964,236.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-18 are presented for examination.
2. The Declaration is defective
 - a. It must state "first". See 37 CFR 1.63(b)(2);
 - b. It must state "sole". See 37 CFR 1.63(a)(4).A new Declaration is required.
3. A 37 CFR 3.73(b) submission has not been received to support action by the assignee. 37 CFR 3.73(b) Submission is required.
4. Original Patent Required Prior to Allowance

The original patent, or a statement as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.
5. Rejection, 35 U.S.C. 251, New Matter

Claims 10-18 are rejected under 35 U.S.C. 251 as being based upon new matter added to the patent for which reissue is sought. The added material "random access memory" (RAM) is not supported by the prior patent. The prior patent is directed to "synchronous dynamic random access memory" (SDRAM).

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1 is rejected under 35 U.S.C. § 103(a) as being unpatentable over **Hwang et al.** (Hwang) patent no. **5,901,304**.

As per claim 1:

Hwang teaches the invention substantially as claimed, including a semiconductor integrated circuit device [Fig. 3A-B] comprising:

a logic circuit [INPUT BUFFER 401 of Fig. 5] and a synchronous dynamic random access memory (SDRAM) including a core unit [DRAM MACRO BANK 202 of Fig. 3A], said logic circuit and said SDRAM being integrated into a single semiconductor chip [Fig. 3A-B]; and

a SDRAM control circuit [command decoder of Fig. 5] receiving external control signals for said SDRAM from said logic circuit [signals ERAS, ECAS, ETC of Fig. 5], and outputting signals to said core unit of said SDRAM [signal 430 of Fig. 5] wherein the output signals from said SDRAM are internal control signals for controlling said core unit of said SDRAM [col. 4 line 60 - col. 5 line 7].

Hwang teaches the IC with embedded DRAM. Hwang does not teach the IC with embedded SDRAM. However, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the teachings of Hwang for the IC with embedded SDRAM. This

modification would have been obvious and a person having ordinary skill in the art would have been motivated to do so because it would enhance the application of Hwang for a high speed DRAM [see Hwang background of the invention].

8. Claim 2-6 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

9. Claim 7-9 are allowed.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Ton, whose telephone number is (703) 306-3043. The examiner can normally be reached Monday through Thursday from 6:30 AM to 4:00 PM and alternate Friday from 6:30 AM to 3:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Albert DeCady, can be reached at (703) 305-9595.

Any inquiry of a general nature of relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

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or faxed to: (703) 746-7239 (Official)
(703) 746-7240 (Non-Official)
(703) 746-7238 (After-Final)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,
Arlington, VA., Sixth Floor (Receptionist).

dt

September 29, 2003



**DAVIDTON
PRIMARY EXAMINER**